REMARKS/ARGUMENTS

Applicant thanks the Examiner for the thorough consideration given the present application. Claims 1-21 are pending in the present application. Claims 1, 8 and 13 are independent claims. Claims 1, 8 and 13 have been amended. The Examiner is respectfully requested to reconsider his rejections in view of the Amendments and Remarks as set forth hereinbelow.

Drawings

The Official Draftsperson has not approved the Formal Drawings submitted by the Applicant. It is respectfully submitted that the drawings comply with the requirements of the USPTO. If the Official Draftsperson has any objections to the Formal Drawings he is respectfully requested to contact the undersigned as soon as possible so that appropriate action may be taken. No further action is believed to be necessary at this time unless the undersigned receives a notice from the Official Draftsperson.

Present Invention

The present invention is generally directed to a protection circuit for protecting a semiconductor laser device from a

surge. The circuit includes a resistor or coil in series with the semiconductor laser device, and a first and second capacitor connected in parallel with the semiconductor laser device on opposite sides of the resistor. The capacitors and resistor are arranged in a Π-type configuration. This type of arrangement obtains a high electrostatic breakdown voltage. One of the capacitors is a high frequency capacitor, while the other is a low frequency capacitor, and the resistor can be replaced with a coil. In another embodiment, the first and second capacitors both include a low frequency capacitor and a high frequency capacitor.

Rejection Under 35 U.S.C. § 102

Claims 1-3, 5-9, 11-13, 15-17, 20 and 21 stand rejected under 35 USC § 102(b) as being anticipated by U. S. Patent No. 5,065,226 to Kluitmans et al. This rejection is respectfully traversed.

It is respectfully submitted that claims 1-3, 5-9, 11-13, 15-17, 20 and 21 are not anticipated by Kluitmans et al. as cited by the Examiner. As set forth in Section 2131 of the MPEP Original Eighth Edition, August, 2001, page 2100-68:

> "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly

> or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. Of California, 814 F2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claims." Richardson v. Suzuki Motor Co., 868 F2d 1226, 1236, 9 USQP2d 1913, 1920 (Fed. Cir. 1989).

FIG. 5 of Kluitmans et al. merely illustrates two capacitors in parallel with a number of coils and a laser device. According to the Examiner, these two (2) capacitors have different values and "therefore, they have different frequency region[s]."

In Kluitmans et al., a laser diode module is provided with a standardized DIL order of the guide pins. The module counteracts rapid increase of a reflection phenomena as a function of frequency and is suitable for use in systems operating at bit rates considerably higher than 1 Gbit/sec. In other words, the invention of Kluitmans et al. is in the laser diode module and the rod-shaped outer guide. Kluitmans et al. is not a protection circuit for a semiconductor laser device. Additionally, Kluitmans et al. does not address higher electrostatic breakdown voltages. In fact, the Examiner does not mention either of these features.

It is respectfully submitted that Kluitmans et al. cited by the Examiner does not set forth each and every feature as now

defined in the independent claims 1, 8 and 13. For example, a Π-type configuration for obtaining high electrostatic breakdown voltage is not found in the prior art reference. Thus, the Examiner's rejection based on 35 USC § 102(b) has been obviated, and it is respectfully requested that the rejection of claims 1-3, 5-9, 11-13, 15-17, 20 and 21 under 35 U.S.C. § 102(b) be withdrawn.

Rejection Under 35 U.S.C. § 103

Claims 4, 10, 14, 18 and 19 stand rejected under 35 USC § 103(a) as being unpatentable over Kluitmans et al. in view of a combination of either U. S. Patent No. 6,346,564 to Kubota et al. or U. S. Patent No. 5,548,291 to Meier et al. It is believed that the Examiner means to add "as applied to the independent claims 1, 8 and 13", as well. This rejection is respectfully traversed.

The Examiner states that Kluitmans et al. does not disclose or suggest a multilayered chip capacitor and chip coil, and the Examiner cites Kubota et al. for allegedly disclosing a multilayered chip capacitor and chip coil. The Examiner suggests that column 8, lines 24-32, of Kubota et al. discusses these features. The Examiner cites Meier et al., because, according to the Examiner, Kluitmans et al. does not disclose first and

second capacitors having a specific capacitance of 1 and 0.1 microfarad.

While Kluitmans et al. appears to show, in FIG. 5, some of the components recited in independent claims 1, 8, and 13, as well as some of the features recited in the dependent claims, Kluitmans et al. does not teach or suggest a resistor or coil and low and high frequency capacitors on either side to a Π-type configuration for obtaining high electrostatic breakdown voltage.

As discussed previously, Kluitmans et al. appears primarily directed to inductance of coils and their relationship to the laser diode module, the goal of Kluitmans et al. is to make the characteristic impedance of the internal transmission line suitable in systems with considerably high frequency rates. Accordingly, Kluitmans et al. is not relevant to the present invention. There is no protection circuit. Additionally, Kluitmans et al does not address electrostatic breakdown voltage nor teach or suggest a Π-type configuration.

Applicant respectfully submits that when one recognizes that a problem exists in the prior art, and thereafter, solves that problem, that the Applicant is entitled to a patent when the prior art fails to teach or suggest the solution thereof.

For example, as stated by Judge Johnson in In re Shaffer, 108 USPQ 326 (CCPA 1956):

> "It is too well settled for citation that references may be combined for the purpose of showing that a claim is unpatentable. However, they may not be combined indiscriminately, and to determine whether the combination of references is proper, the following criterion is often used: namely, whether the prior art suggests doing what an applicant has done …. Furthermore, when references are combined to negate patentability, it should also be considered whether one skilled in the art with the references before him could have made the combination of elements claimed without the exercise of invention … it is not enough for a valid rejection to view the prior art in retrospect once an applicant's disclosure is known. The art applied should be viewed by itself to see if it fairly disclosed doing what an applicant has done. If the art did not do so, the references may have been improperly combined."

It is respectfully submitted that a rejection under 35 U.S.C. § 103 is not proper unless the prior art provides a teaching for combining the references so as to render obvious the subject matter set forth in the claims. As set forth in Diversitech Corp. v. Century Steps, Inc., 7 USPQ2d 1315 (Fed. Cir. 1988) the Court stated:

> "The problem confronted by the Inventor must be considered in determining whether it would have been obvious to combine references in order to solve that problem ...."

In the specific situation presented to the Examiner, the Examiner acknowledges that Kluitmans et al. fails to disclose specific features as set forth in the claims. The disclosures set

forth in Kubota et al. or Meier et al. do not overcome the deficiencies of Kluitmans et al. There is no teaching or motivation to modify the circuit of Kluitmans et al. to a protection circuit or form a ∏-type configuration for obtaining high electrostatic breakdown voltage.

Under the provisions of 35 U.S.C. § 103, the Examiner is not permitted to selectively extract a single concept of utilizing a laser diode module while ignoring the teaching that motivated Kluitmans et al. to develop his invention. Kluitmans et al. is a laser diode module not a protection circuit. The Examiner's rejection is based on a hindsight reconstruction of the prior art with the Examiner relying on the Applicant's own disclosure for providing the motivation to make the modification. Such a rejection is not sanctioned by the provisions of 35 USC 103.

As set forth in Section 2143.01, the eighth paragraph of the MPEP:

> "If [a] proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984)."

Applicant respectfully submits that the proposed modification by the Examiner of Kluitmans et al. in view of either Kubota et al. or Meier et al. renders Kluitmans et al.

unsatisfactory for its intended purpose and thus is not sanctioned by the provisions of 35 U.S.C. § 103.

Accordingly, it is respectfully requested that the rejection of claims 1, 4, 8, 10, 13, 14, 18 and 19 under 35 U.S.C. § 103(a) based on Kluitmans et al. in view of a combination of Kubota et al. or Meier et al. be withdrawn.

Conclusion

In view of the above amendments and remarks, reconsideration of the rejections and allowance of all of the claims are respectfully requested.

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Daniel K. Dorsey (Reg. No. 32,520) at the telephone number of (703) 205-8000, to conduct an interview in an effort to expedite prosecution in connection with the present

application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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